

## **REMARKS**

### **Summary**

In the Notice of Non-Responsive Amendment, Examiner noted that the amended claims included in Applicant's Response to the underlying Office Action dated December 1, 2004 failed to provide appropriate interlineations identifying added and deleted text. Applicant acknowledges and thanks Examiner for the opportunity to address the inadvertent omissions. This submission cures those deficiencies.

In the Office Action dated December 1, 2004, Claims 1-14 were rejected under 35 U.S.C. § 101, Claims 1-2, 7-16, 19-23 and 26-28 were rejected under 35 U.S.C. § 102, and Claims 3-6, 17-18 and 24-25 were rejected under 35 U.S.C. § 103.

Applicant amends Claims 1, 15, and 22 to further particularize the invention. The amendments do not introduce new matter.

Applicant adds Claims 29-33 to more fully claim embodiments of the invention. The additional claims do not introduce new matter.

Therefore, Claims 1-33 are pending.

### **Rejections Under 35 U.S.C. § 101**

Claims 1-14 remain rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In particular, the Office Action states that the claims have no connection to the technological arts. While respectfully disagreeing with the Examiner as indicated in the previous response, Applicant nonetheless amended Claim 1 to add "In an electronic delivery address service..." to the preamble to expedite the examination. The Examiner asserted that this amendment was insufficient to overcome the rejection.

Applicant respectfully disagrees with this characterization of previously amended Claim 1 and asserts that the amendment clearly provides the “connection to the technological arts” as required by the Examiner since the method is performed by an “electronic delivery address service.” Nevertheless, in an effort to expedite prosecution, Applicant has elected to clarify the language of claim 1 to further demonstrate application in the advancement of the technological arts. Applicant submits that such amendment is not intended to be narrowing and has not been made to overcome any rejections based upon the prior art.

For at least the reasons articulated above, Applicant respectfully requests that the Examiner withdraw the 35 U.S.C § 101 rejections against Claims 1-13, as the claims are clearly directed towards “useful” things and, therefore, are directed towards statutory subject matter.

Applicant’s amended claim 1 now reads:

In an electronic delivery address service, a method comprising:  
receiving by the delivery address service via electronic communication, an electronic subscription from a subscriber, the received subscription including a mailing address of the subscriber;  
in response, the **delivery address service electronically generating a substitute delivery address;**  
transmitting by the delivery address service via electronic communication the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good;  
receiving by the delivery address service via electronic communication, an electronic notification of either a request to deliver or an arrival of the purchased good, as a result of **the substitute delivery address being used by the subscriber in the online purchase of the good;** and  
intervening by the delivery address service by electronically communicating the provided mailing address of the subscriber to the delivery service to facilitate delivery of the purchased good to the subscriber.

(emphasis added).

Rejections Under 35 U.S.C. § 102(e)

The Examiner maintained the rejections against Claims 1-2, 7-8, 10-16, 19-23 and 26-28 under 35 102(e) as being fully anticipated by U.S. Patent Application Publication No. 2002/0013739 to O'Donnell et al. ("O'Donnell").

In response Applicant, while disagreeing with the Examiner's analysis, to expedite the examination has amended Claim 1 to further particularize the invention. In addition to the points previously raised by the Applicant, amended Claim 1 now requires the ***delivery address service generating a substitute delivery address and transmitting the substitute delivery address to the subscriber, for the subscriber to use in an online purchase of a good.*** Now, even if the Examiner's position that the O'Donnell shipping computer (40) transmitting data to the user computer (20) is the equivalent of "providing" to the subscriber a substitute address is accurate, O'Donnell does not teach of ***the delivery address service generating a substitute delivery address, and the same delivery address service transmitting the substitute address to the subscriber, for the subscriber to use in an online purchase of a good.*** Rather, O'Donnell merely teaches of a central processing computer (10) generating a substitute address, then the central processing computer transmitting to the provider computer (30) the substitute address. There is no teach or suggestion of the O'Donnell shipping computer (40) ***generating and transmitting a substitute delivery address to the user computer (20) for a subscriber to use in the purchase of an online good.***

Accordingly, Claim 1 is clearly patentable over O'Donnell.

Claims 15 and 22

Claims 15 and 22 contain in substance the same required elements of Claim 1. Accordingly for at least the same reasons, Claims 15 and 22 are patentable over O'Donnell under sec 102(e).

Claims 2, 7-14, 16, 19-21, 23, and 26-28

Claims 2, 7-14, 16, 19-21, 23, and 26-28 depend from Claims 1, 15 and 22. Due at least in part on their dependency, Applicant submits that Claims 2, 7-14, 16, 19-21, 23, and 26-28 are also in proper form for allowance.

Rejections Under 35 U.S.C. § 103

The Examiner also maintained the rejections against Claims 3-6, 17-18, and 24-25 under 35 U.S.C. § 103(a) as being unpatentable over O'Donnell in view of U.S. Patent Application No. 6,336,100 issued to Yamada ("Yamada"),

Applicant submits that Yamada does not cure the above mentioned deficiencies of O'Donnell as applied to at least Claims 1, 15, and 22. In particular, at the very least Yamada does not teach or otherwise suggest that a delivery address service generates and transmits a substitute delivery address to a subscriber for the subscriber to use for the purchase of an online good.

Therefore based at least in part on their dependencies of Claims 1, 15 and 22, Applicant submits that Claims 3-6, 17-18 and 24-25 are patentable over O'Donnell, whether alone or in combination with Yamada, and thus are in proper form for allowance.

### New Claims 29-33

Claim 29 contains in substance the same required elements of Claim 1, and claims 30-33 depend on claim 29. Accordingly for at least the same reasons, Claims 29-37 are patentable over O'Donnell under sec 102(e) and over O'Donnell whether alone or in combination with Yamada under sec. 103(a).

**CONCLUSION**

Applicant has further endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action.


In light of the above remarks, Applicant submits Claims 1-33 are in condition of allowance. Early issuance of Notice of Allowance is respectfully requested.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,

SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: 5/18/05

  
\_\_\_\_\_  
Mark C McClure  
Registration No. 53,857

Pacwest Center, Suites 1600-1900  
1211 SW Fifth Avenue  
Portland, Oregon 97204  
Telephone: 206.407.1504